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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,586	11/21/2003	Hiroyuki Okuhira	ION-0218	9398
23353	7590	12/08/2005	EXAMINER	
RADER FISHMAN & GRAUER PLLC			ROBERTSON, JEFFREY	
LION BUILDING			ART UNIT	
1233 20TH STREET N.W., SUITE 501			PAPER NUMBER	
WASHINGTON, DC 20036			1712	

DATE MAILED: 12/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/717,586

Applicant(s)

OKUHIRA ET AL.

Examiner

Jeffrey B. Robertson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0204</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 4-7, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by König et al. (U.S. Patent No. 4,242,410).

For claims 1 and 2, König teaches a curing component that is the mixture of polyamines and ketones, where the reaction forms ketimine and water. Col. 3, lines 54-60. For claim 4, here König teaches that additional water may also be added. For claim 5, König teaches ratios that overlap those claimed by applicant in col. 3, line 66 through col. 4, line 8.

For claims 6 and 7, König discloses prepolymers derived from polyisocyanates and polyols, i.e. polyurethanes in col. 3, lines 1-17. For claim 13, König teaches that preferred isocyanates include those containing isocyanates that are bonded to secondary or tertiary carbon atoms in col. 2, lines 66-68.

3. Claims 1, 3-7, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Pedain et al. (U.S. Patent No. 4,895,883).

For claims 1, 3, and 4, Pedain teaches a curing agent containing a ketimine component, water, and amine in col. 7, lines 38-65. Here, Pedain teaches that

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hydrolytic cleavage occurs indicating that ketone is present. For claim 5, Pedain teaches ratios that overlap those claimed by applicant in col. 5, line 63 through col. 6, line 2.

For claims 6 and 7, Pedain teaches polyurethane prepolymers in col. 3, lines 3-11. For claim 13, Pedain teaches that preferred isocyanates include those containing isocyanates that are bonded to secondary or tertiary carbon atoms in col. 2, lines 62-66.

4. Claims 1, 4-6, and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Brindell et al. (U.S. Patent No. 4,184,950).

For claims 1, 4, and 5, Brindell teaches curing components containing an amine and ketimine. See Example 1. Note that there is water present, which would result in the presence of a ketone. Here, for claims 6 and 8, Brindell teaches that an epoxy resin prepolymer is used.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 3, and 6-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Okuhira (U.S. Patent No. 6,271,333).

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Okuhira teaches a composition that contains an organic polymer having at least one reactive silyl group, an isocyanate, and a ketimine curing agent. Col. 1, lines 50-62.

For claims 6, 7, 9, and 13-16, Okuhira teaches that the isocyanate compound is a urethane prepolymer that is derived from isocyanates where the isocyanate is bound to a tertiary or secondary carbon. Col. 6, lines 20-28 and 41-45. For claims 8 and 9, in col. 17, Okuhira teaches that an epoxy resin may be added to the composition. Col. 17, lines 52-62. For claims 10-12, the organic polymer having a silyl group is the prepolymer other than the urethane and epoxy prepolymers.

For claims 1 and 3, Okuhira teaches that the composition is taken out of sealed containers and exposed to moisture in the air. Col. 18, lines 61-64. The examiner's position is that when moisture from the air is added to the composition, applicant's claimed curing component inherently results, which is consistent with the limitations set forth for claim 3. "[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. 102, on prima facie obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F. 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977)).

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Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. McFadden (U.S. Patent No. 4,353,819), Pedain et al. (U.S. Patent No. 5,068,402), and Hayashi et al. (U.S. Patent No. 6,037,435) are cited for general interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey B. Robertson
Primary Examiner
Art Unit 1712

JBR